

Objection to Claims

Claims 2 and 21-24 were objected to based on lack of antecedent basis. Claim 2 is amended to provide proper antecedent basis. Applicant now requests withdrawal of this objection.

Prior Art Rejection

Claims 1-31 were rejected under 35 U.S.C. §103(a) over Austrian reference 405,560 in view of any of Schied or Nemeth or German reference 3,117,605 or German reference 29703962 when considering Roesch et al. In this rejection, the Examiner is of the opinion that one of ordinary skill in the art would be motivated to combine the flooring system in Austrian reference 405,560 with a glue taught in one of the remaining references. More specifically, in response to Applicant's previous arguments, the Examiner suggests

“The motivation for combining is set forth in the above rejection. One of ordinary skill in the art would have found it obvious to utilize adhesive with the Austrian ‘560 tongue and groove panel connection for the purpose of achieving a secure connection between adjacent panels with advantages of utilizing ‘two component adhesives’ being affected”

Applicant disagrees with this argument and respectfully traverses this rejection.

Applicant submits that it is a well-known principal that the prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. (*Amgen, inc. v. Chigai Pharmaceuticals Co. Ltd.*, 927 F.2d 115, 117, 18 USPQ2d 1016 (Fed. Cir. 1988); *In re Regel*, 526 F.2d 1399, 1403, 188 USPQ 136, 139 (CCPA 1975).)

Now, the Austrian reference 405,560 is directed to tongue and groove flooring panels having a locking mechanism. In this reference, a projection snaps into the undercut of the tongue

and locks the adjacent panels to one another without any need for glue or other adhesives. The flooring panels thus do not require glue. For this reason, Applicant submits that the Australian reference, itself, does not teach the desirability to have glue and that one of ordinary skill in the art would not have known to use glue with this flooring panel system.

Nemeth, Scheid, DE-29703962 U1 and DE 29703962 are all directed to simple tongue and groove connections, without the use of a locking mechanism. These types of systems are addressed in the prior art section of the specification. In all of these systems, glue is used to attach the panels together via the tongue and groove system. The use of the glue allows the flooring panels to remain attached together since there is no other type of locking mechanism¹. The only suggestion within these references is to use glue with a simple tongue and groove mechanism. None of these references would provide any motivation for one of ordinary skill in the art to use the glue in a flooring panel which has a locking mechanism integrated with the tongue and groove system, such as that in Australian reference 405,560. The use of impermissible hindsight reasoning based on Applicant's own disclosure would appear to be the only motivation.

The Examiner is also of the opinion that

“[t]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.”

Applicant, however, submits that the rationale to modify the references, as suggested by the Examiner, is not in the prior art, expressly or impliedly, nor can it be reasoned from knowledge generally available to one of ordinary skill, etc. Specifically, Applicant submits that the prior art references clearly do not expressly teach the combination as suggested by the Examiner. The

¹ Schied also discloses the use of nails. But there is no locking mechanism associated with the tongue and groove, itself.

references to Schied or Nemeth or DE 3,117605 or DE 29703962 teach the use of glue with a tongue and groove panel system having no locking mechanism. The use of glue is thus critical in the systems of these references in order to allow the panels to remain attached together. But, there is no express teaching to use glue with panel systems having a locking mechanism. On the other hand, the Austrian reference shows a panel system having a locking mechanism, but without the need for glue. Thus, this reference also does not expressly teach the combination as suggested by the Examiner.

As to impliedly teaching the combination, it is submitted that Schied or Nemeth or DE 3,117605 or DE 29703962 are directed to simple tongue and groove connections, without the use of a locking mechanism. These are the same type of systems as discussed in the prior art section and which leads to the same disadvantages (i.e., making it impossible to adjust the glued joint in the longitudinal direction for the purpose of closing a transverse joint) which are overcome by the present invention. It would thus seem that there is no implied teaching to use the glue in another system, which has a locking mechanism.

Now, it is also Applicant's knowledgeable opinion that one of ordinary skill in the art would not have reasoned from knowledge generally available to one of ordinary skill in the art to make the modification suggested by the Examiner. As noted above, the Austrian reference already includes a locking mechanism. There would be no need for glue in this system, and one of ordinary skill in the art would not have placed glue in a system which already contains a locking mechanism. Also, Schied or Nemeth or DE 3,117605 or DE 29703962 have glue but do not need a locking mechanism in order to achieve their objectives. It is thus submitted that each of the references applied by the Examiner meet their objectives and any modification can only be based on hindsight reasoning.

Applicant further submits that when the problem or the source of the problem is not even recognized in the art, the claimed invention may be considered a patentable invention even if the constituent parts of the claimed invention are found in the applied references. Specifically, *In re Peehs* held, in part

“[a] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the ‘subject matter as a whole’ [test] which should always be considered in determining the obviousness of an invention under 35 U.S.C. §103.”

In re Peehs, 612 F.2d 1287, 204 USPQ 835 (CCPA 1980)

In view of the above holding, Applicant submits that one of ordinary skill in the art did not even recognize the problem which is solved by the present invention. That is, Applicant submits that this problem is not even recognized in any of the references and, as such, the benefits of the present invention would not have even been known prior to the present invention. Accordingly, even if a combination of references teaches the constituent parts (which it does not as discussed in further detail below), it certainly is not obvious to combine such references. Since the problem is not recognized in any of the references, Applicant submits that the solution would then not be obvious. Accordingly, Applicant again submits that the Examiner is using impermissible hindsight reasoning based on Applicant’s disclosure in order to achieve the claimed invention based on the combined references.

It is further submitted that the references do not even teach all of the limitations of the claimed invention. Namely, the references do not teach the use an adhesive layer, or a substance which activates an adhesive, applied to the groove at least in the area of its divergent sides or to the tongue at least in the area of its divergent wedge-shaped area, or to both areas. This cannot be taught by Schied or Nemeth or DE 3,117605 or DE 29703962 since such references teach the use of simple tongue and groove mechanisms without such features as described in the claimed invention, i.e., a locking mechanism. Additionally, Austrian reference 405,560 does not teach the use of glue, at all. Thus, there would be no teaching of the features of the claimed invention, either impliedly or expressly, in any of the references.

It is also submitted that the gluing system of some of these panels systems of the prior art would not result in the advantages of the present invention. In fact, the present invention was specifically designed to overcome the exact shortcomings of using conventional systems. For

example, by using the glued systems of the prior art, the two surfaces that come into contact must be pressed together with a considerable degree of pressure, making it impossible to additionally adjust the glued joint in the longitudinal direction for the purpose of closing a transverse joint. Accordingly, Applicant submits that there would be no motivation to one of ordinary skill in the art to use the glue of this conventional tongue and groove system in the Austria reference 405,560 which includes a locking mechanism integrated with the tongue and groove system.

Conclusion

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a stylized flourish extending from the end.

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Marked-Up Copy of Claims

The following is a marked-up copy of amended claim 2.

2. (Thrice Amended) A configuration according to claim 1, wherein:

[the] locking elements are on at least one side of the groove and at least one side of the tongue, the locking elements conform to each other and extend over the entire length of the groove and the tongue are provided in the form of an indentation or recess and a projection, in order to hold connected components in a joined position;

the groove is formed directly in the component or is worked out of the same in order to provide for a connection of the components;

the tongue forms a single piece with the component or is worked out of the same;

a width of the groove increases from inside outward;

a thickness of the tongue decreases in the direction of an unattached end;

the projection on the tongue is triangular and exhibits a shorter back surface and a longer front surface;

the recess in the groove exhibits a shorter contact surface that lies at a distance from the groove base and that rests against the shorter back surface of the projection;

at least one of the two groove sides flex elastically and outwards relative to the other groove side so that in a locked position the tongue is held by the groove sides with a squeezing action or is inserted into the groove while the groove sides bend elastically;

an angle between the longer front surface and the shorter back surface is 1000 to 1400;

two legs of the groove are equally as long as the respective longer front surface and the shorter back surface;

the recess in the groove exhibits a contact area close to the groove base that in the locked position at least partially rests against the longer front surface;

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the longer front surface close to the groove base, or the section of the tongue area received by the recess, is four to eight times as long as the shorter back surface; and

the tongue is provided with the layer of adhesive or with the adhesive with an activating substance on at least the contact surface of the groove walls close to at least one of the groove base and on the longer front surface of the tongue.

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